



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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(2) On March 24, 2000, Applicant submitted a Petition requesting that the U.S. PTO accept this application under 37 C.F.R. § 1.47(a) because one joint inventor (Kevin Warne) could not be located to sign the Declaration for this application;

(3) On June 20, 2000, the U.S. PTO DISMISSED Applicant's Petition because the previously submitted Declaration did not identify Mr. Warne as an inventor and because a statement of Mr. Warne's last known address was not included;

(4) On November 6, 2000, Applicant submitted a Petition Under 37 C.F.R. § 1.183 requesting that the U.S. PTO waive the requirement to state the last known address of Mr. Warne because Applicant did not know this information. Also, at this time, Applicant submitted a new Declaration form that identified Mr. Warne as an inventor. The remaining joint inventors signed this new Declaration, and the space for Mr. Warne's signature was left blank;

(5) On April 19, 2001, the Office GRANTED Applicant's Petition to waive the requirement to state Mr. Warne's last known address. However, the Office DISMISSED Applicant's Petition to be accorded status under 37 C.F.R. § 1.47(a) because the Declaration submitted November 6, 2000 did not state the citizenship of Mr. Warne.

(6) On May 15, 2001, Applicant requested Reconsideration of the Petition under 37 C.F.R. § 1.47(a). In that paper, Applicant advised that it could not state the citizenship of Mr. Warne because Applicant did not know his country of citizenship.

(7) On June 14, 2001, the Office again DISMISSED Applicant's Petition under 37 C.F.R. § 1.47(a) because the Declaration submitted with the Petition under 37 C.F.R. § 1.47(a) did not state Mr. Warne's country of citizenship. In that paper, the Office asserted that:

[t]he requirement that the citizenship of an inventor be provided on the declaration is a requirement established by statute and cannot be suspended or waived. See 35 USC 115. Accordingly, this information must be provided in order to submit a declaration in compliance with 35 USC 115 and 116, and 37 CFR 1.63 and 1.64.

(8) This present paper responds to the June 14, 2001 Decision and requests reconsideration of Applicant's Petition Under 37 C.F.R. §1.47 (a) and waiver of the requirement of the rule that a patent applicant submit a Declaration including the citizenship of a nonsigning inventor.

#### **REMARKS**

Applicant respectfully submits that, under the present circumstances, there is no statutory requirement that a patent applicant state the citizenship of an inventor that cannot be located and/or refuses to sign a patent application.

The Office is correct that 35 U.S.C. § 115 includes a requirement that an inventor submit an oath or declaration that states his/her country of citizenship. However, the patent statute includes an express exception and alternative filing procedure when an inventor cannot be located and/or refuses to sign a patent application. This exception is set forth in 35 U.S.C. § 118 as follows:

#### **35 U.S.C. 118 - Filing by other than inventor.**

Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage; and the Director may grant a patent to such

inventor upon such notice to him as the Director deems sufficient, and on compliance with such regulations as he prescribes.

Notably, this statute contains no requirement for an oath or declaration of any kind on behalf of the nonsigning inventor. Thus, for patent applications filed under the exception provided in 35 U.S.C. § 118, like the present application, there is no statutory requirement that the patent applicant include an oath or declaration stating the citizenship of the nonsigning inventor.

Rather, for applications filed under the provisions of 35 U.S.C. § 118, the Director may allow the application to proceed to issuance of a patent “upon such notice to [the nonsigning inventor] as the Director deems sufficient, and on compliance with such regulations as [the Director] prescribes.” Pursuant to this authority, the Director of the Patent and Trademark Office has promulgated regulations describing the procedure to be followed when filing a patent application under the exception provided by 35 U.S.C. § 118. Specifically, 37 C.F.R. § 1.47(a) provides as follows:

**§ 1.47 Filing when an inventor refuses to sign or cannot be reached.**

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

This regulation includes the only requirement that a patent applicant submit an oath or declaration in an application filed under the exception provided in 35 U.S.C. § 118.

Because the requirement for an oath or declaration identifying the country of citizenship of a nonsigning inventor in an application filed under 35 U.S.C. § 118 is a requirement only of

the patent regulations, and not a requirement of the underlying, relevant statute (35 U.S.C. § 118), the U.S. PTO can waive this requirement. Applicant respectfully submits that the present combination of circumstances is so unique and extraordinary that justice permits waiver of this requirement, as authorized by 37 C.F.R. § 1.183. The relevant facts are outlined below:

(1) As described in Applicant's previously submitted Petition papers, the nonsigning inventor, Mr. Warne, was a consultant hired by the Assignee of this patent application. See, for example, the Declaration of D. Bartley Eppenauer, ¶ 2 (filed March 24, 2000). Because Mr. Warne was a consultant, not a Microsoft employee, Microsoft does not have a personnel file for Mr. Warne that identifies his country of citizenship. Microsoft does not know Mr. Warne's country of citizenship. See the Request for Reconsideration of Petition under 37 C.F.R. § 1.47(a) filed May 15, 2001.

(2) Microsoft made numerous efforts to contact Mr. Warne. These efforts were unsuccessful. See, for example, the Declaration of D. Bartley Eppenauer filed March 24, 2000.

Given these unique and extraordinary circumstances, Applicant respectfully requests that the U.S. PTO waive the requirement of 37 C.F.R. § 1.47(a) that Applicant submit an oath or declaration identifying the country of citizenship of the nonsigning inventor, Mr. Warne. Because this application has been filed under the exception provided in 35 U.S.C. § 118, and because 35 U.S.C. § 118 does not include a requirement for an oath or declaration by the nonsigning inventor, this request for waiver of the rules does not require waiver of a statutory requirement.

### CONCLUSION

In view of all of the foregoing, Applicant respectfully requests that the Office WAIVE the requirement of 37 C.F.R. § 1.47(a) that an oath or declaration submitted in an application filed pursuant to 35 U.S.C. § 118 identify the country of citizenship of the nonsigning inventor. Applicant further requests that the Office then GRANT the previously submitted Petition Under 37 C.F.R. § 1.47(a).

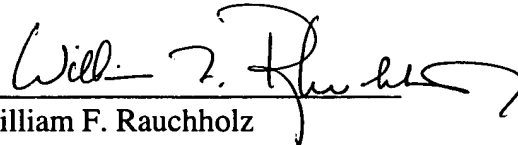
Respectfully submitted,

BANNER & WITCOFF, LTD.

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